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Art Unit: **3749** Examiner: Stephen **Gravini**

Fax No: 571-273-8300

From: Donna G. Schneider , Tel: 719-685-4700, Fax: 719-685-3626

RE: Application Number: **10/684,312**

Applicant: SCHNEIDER, D.G.

Total pages transmitted (including this cover): 21

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- (1) Cover
- (1) Transmittal Form
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PTO/SB/21 (09-04)

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/684,312	
	Filing Date	12/15/05	
	First Named Inventor	Schneider, D.G.	
	Art Unit	3749	
	Examiner Name	S. Gravini	
Total Number of Pages in This Submission	21	Attorney Docket Number	DGS001

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name		
Signature	<i>Donna Gail Schneider</i>	
Printed name	Donna Gail Schneider	
Date	December 15, 2005	Reg. No.

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Typed or printed name	Donna Gail Schneider	Date	12/15/05

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/5B/17 (12-04v2)

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**
For FY 2005☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

Complete If Known

Application Number	10/1284,312
Filing Date	12/15/05
First Named Inventor	Schneider, D.G.
Examiner Name	S. Gravini
Art Unit	3749
Attorney Docket No.	DGS001

METHOD OF PAYMENT (check all that apply)
☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☐ Deposit Account Deposit Account Number: _____ Deposit Account Name: _____

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 20 or HP = _____ x _____ = _____	Multiple Dependent Claims
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HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 3 or HP = _____ x _____ = _____	
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HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Filing A Brief in Support of an Appeal 825000**SUBMITTED BY**

Signature	<u>Donna Gail Schneider</u>	Registration No. (Attorney/Agent)	Telephone <u>719-685-4700</u>
Name (Print/Type)	<u>Donna Gail Schneider</u>	Date	<u>12/15/05</u>

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Donna G. SCHNEIDER	Conf. No.: 3321
Application No.: 10/684,312	Group Art Unit: 3749
Filed: October 10, 2003	Examiner: S. Gravini
Attorney Docket: DGS001	

For: COLLAPSIBLE HEATING APPARATUS

APPEAL BRIEFHonorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated October 16, 2005. This Appeal Brief is believed to be timely and properly filed along with the appropriate fees, yet if it is found deficient in content, form or additional fees required to avoid abandonment, please contact the undersigned to expeditiously fulfill any such requirements.

I. REAL PARTY IN INTEREST

Applicant Donna G. Schneider is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

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III. STATUS OF THE CLAIMS

Claims 1-16 are pending in this appeal, in which no claims have earlier been canceled or withdrawn. None of the claims are presently allowed. This appeal is therefore taken from the final rejection of claims 1-16 on May 17, 2005.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been filed since the final rejection of claims 1-16 on May 17, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention addresses problems in the context of portable heating devices. In the subject Application, Applicant describes a need for a heating implement for heating food, beverages or other items when a conventional oven or stove is unavailable. A portable heating device may be needed while camping or hiking, while at construction sites or in the event of power outages or natural disasters. The heating device is preferably portable, lightweight and compactly stored.

Applicant explains that "the devices of the prior art do not adequately accommodate the need to selectively provide an oven suitable for baking, a stove top suitable for heating items held in other containers, and an open grill surface suitable for heating items directly over a flame or heat source. The present invention provides for a single compact unit that, in various configurations, may be used in all of these capacities. Aside from adaptability for use in a wide variety of configurations, further improvements are realized in various embodiments as to the

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degree of compactness and lightweightness and in ease of manufacture and use. (See e.g., Specification para. 0006-0007)

The present invention provides for supporting items to be heated over a heat source. Items are supported using, in the construction of an implement according to an embodiment of the subject invention, a collapsible frame for suspending an item above a heat source. The frame, formed of panels which cooperatively engage one another to form sides of the frame when the frame is erected, is preferably rigid and self-supporting even when constructed in an open fashion as depicted in FIG 1. (See also e.g., Specification para. 0020, 0024)

As described in Applicant's Specification (e.g., para. 0031), variable arrangements of panels may be used in erecting the frame. Applicant's FIG 3 depicts one arrangement wherein the frame 102 is optionally placed between a top cover 310 and a base 320. In particular, this diagram shows that a side of the frame is enclosed by selectively assembling the side using panels 304, 302 and 307. The position of grill 108 may be varied, for example, by placing these panels in a different vertical order during the assembly of the frame. (See e.g., Specification para. 0031; FIGs 3,4,5) Furthermore, it can be seen that the degree to which the one side is enclosed could be varied by excluding one or more of the panels. (See e.g., Specification para. 0031; FIGs 3,4,5) The position at which an opening might be formed may also be readily selected by a user simply by changing the relative positioning of the panels used along the given side during assembly. (See e.g., Specification para. 0008, 0037)

In comparison to FIG 3, FIG 4 depicts one such alternative arrangement wherein only panel 307 is used to enclose the bottom portion of the side, leaving off the upper top portion of the side for facilitating grilling. In this configuration, the grill 108 may also be brought closer to the heat source 315 (note the removal of a narrow panel 302), if desired for grilling purposes or

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other similar uses. In contrast, the higher grill setting and fully enclosed arrangement of FIG 3 may be better suited for baking.

If panels are chosen to be of properly chosen different dimensions (See eg. Specification para. 0033), then a wide range of combinations are made possible without adding weight or complexity to the manufactured article.

These figures and the accompanying description are supportive of Applicant's recited claims. Applicant recites in the present version of the claims "A device facilitating the heating of items, the device comprising: a collapsible frame for suspending an item above a heat source (See e.g. FIGs 1, 2, 3, 4), the frame comprising: a plurality of panels forming sides of the frame when the frame is erected (See e.g., 102, 302, 304, 307 in FIGs 1, 3, 4, 6), wherein a side of the frame comprises a variable configuration of panels (FIG 3,4), the configuration being selected by a user of the device to adjust an attribute of the enclosure, including at least one of: how much of the side is enclosed (See e.g., Specification para. 0031; FIGs 3,4,5), which portion of the side is enclosed (See e.g., Specification para. 0008, 0015, 0037) , a volume substantially enclosed by the frame (See e.g., Specification para. 0011; FIGs 3,4,5) and an overall shape of the frame (See e.g., Specification para. 0011, 0019, 0021, 0030, 0037).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-7 and 14-16 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Slattery (U.S. Patent 4,508,096).

Whether claims 8-13 are unpatentable under 35 U.S.C. § 103(a) in view of Slattery and Bach (U.S. Patent 6,439,225).

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VII. ARGUMENTS**A. CLAIMS 1-7 AND 14-16 ARE NOT ANTICIPATED BY SLATTERY**

To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

A prior art reference anticipates a patent claim if it discloses every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

However, the Examiner's entire and only remark in making the rejection based on this reference is as follows: (from page 2 of Final Office Action dated May 17, 2005)

"Claims 1-7 and 14-16 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Slattery (US 4,508,096)."

This short statement fails to establish the aforementioned requisite grounds for rejection under 102(b) and contravenes 35 U.S.C. § 132 which requires the Director, in making rejections, to "notify the applicant thereof, stating the reasons for such rejection." This statute is violated if

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the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is also expressed in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." In this instance, it is evident in the record that Applicant has been unfairly denied these important considerations in the course of the prosecution.

It is also worth noting that *Slattery* was cited by Applicant in an Information Disclosure Statement prior to the first Office Action. It seems untenable that if the Examiner believes the claims are so apparently anticipated by the reference that no explanation is required, then the reference was only recently concluded to be anticipatory after a series of previous Office Actions. Any intervening amendments by Applicant were of such nature that they could not have created an anticipatory situation if it was not already present earlier.

Despite having no indication from the Office as to the manner in which each of Applicant's claim elements are allegedly met by the teachings of *Slattery* to meet the requirements of a 102(b) rejection, Applicant nevertheless responded to the recent Final Office Action as best as it could be understood, contending that *Slattery* does not, in fact, fulfill or anticipate Applicant's recited claims.

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1. Independent claim 1 is not anticipated by Slattery

In its current form, Applicant's independent claim 1 recites a "...plurality of panels forming sides of the frame when the frame is erected, wherein a side of the frame comprises a variable configuration of panels, the configuration being selected by a user of the device to adjust an attribute of the enclosure when the device is in use for heating, the attribute including at least one of: how much of the side is enclosed, which portion of the side is enclosed, a volume substantially enclosed by the frame and an overall shape of the frame."

Slattery does not teach or suggest that "a side of the frame comprises a variable configuration of panels" as recited by Applicant (See e.g., Specification para. 0031 and FIGs 3,4,5). The remarks in the Action do not account for how this recitation is allegedly met by Slattery. In contrast to Slattery, please note Applicant's FIGs 3-6, clearly depicting that a given side of the erected frame is subject to various configurations using a variable configuration of panels.

To construct a heating unit according to Slattery, two end plates 26, 28 are attached to a base 12 using fasteners 16, such as wing nuts. Then the side plates 22, 24 are set into place forming an enclosure in cooperation with the composite structure already formed by the base and side plates. The side plates and end plates alone do not significantly couple with one another to form a frame for suspending an item above a heat source. The Office fails to show that the plates 22, 24, 26 and 28, devoid of base 12 and any other means of coupling beyond what is taught in Slattery, form a 'frame' *per se* that can be erected and be capable of supporting or suspending items above a heat source. In accordance with Applicants teachings, the formation of a frame is desirable for facilitating assembly, without requiring a base member (See e.g., Specification para. 0009,0026,0029), and for allowing the frame, even while supporting food

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items thereon, to be lifted intact up and away from the heat source. This is useful, for example, for allowing repositioning of fuel materials without having to move items off of the grill (See e.g., Specification para. 0029). Applicant's approach also facilitates assembling the unit in free space or when a flat, hard surface is not readily available (See e.g., Specification para. 0016, 0020, 0024).

Consequently, Appellant respectfully submits that Slattery does not anticipate Applicant's independent claim 1 and that the Office has failed to demonstrate otherwise. The rejection of independent claim 1 based on Slattery should be reversed.

2. Dependent claims 2-7 and 14-16 are not anticipated by Slattery

As the remainder of claims 2-7 and 14-16 depend from claim 1, they are each allowable at least by virtue of their dependence from claim 1 in light of the foregoing arguments. Furthermore, each of these claims are separately patentable on their own merits.

Appellant further argues the patentability of claims 2 and 3 in their own right with respect to Slattery. Slattery does not teach or suggest that the panels are detachably coupled to one another, nor, as claim 3 specifies, that they are detachably coupled to one another substantially along their adjacent edges. In accordance with Slattery, the panels only come into proximity with one another, and only by virtue of the end panels being fixed in place to the base using fasteners. Slattery fails to show coupling among the panels and the formation of an erect frame as Applicant has claimed. At least for these reasons, the rejection of claims 2 and 3 put forth allegedly based upon Slattery should be reversed.

For the foregoing reasons, Applicant respectfully contends that the Examiner has failed to meet two burdens: that of showing how Slattery in any way anticipates Applicant's claimed

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invention and that of providing Applicant with adequate notice regarding the substance of the rejection so as to fairly and effectively address the matter. For these reasons, Applicant requests that the rejections under 35 U.S.C. § 102 based upon Slattery be reversed.

3. An ambiguity in another part of the recent Action may reflect on the patentability of independent claim 1 with respect to Slattery

Another consideration pertaining to the rejection under 35 U.S.C. § 102 arises due to the nature and arrangement of the Examiner's remarks in the Office Action concerning other rejections under 35 U.S.C. § 103. In the rejections of other claims under 35 U.S.C. § 103, the remarks in the action indicate Slattery and Bach as the basis of the rejection and then abruptly refers to 'Hait' instead. Appellant is unsure whether the Examiner intended to refer to Slattery at this point. Here the remarks in the Action state that the reference being applied "is considered to disclose the claimed invention ... except for the claimed selective configuration." If the mention of Hait in the rejection under 35 U.S.C. § 103 is a clerical error and the Examiner indeed intends to refer to Slattery for that rejection, then Appellant contends that this is an admission by the Examiner that Slattery fails to meet limitations pertaining to selective configurability. Yet, very importantly, such limitations are recited in Applicant's independent claim 1 and differentiate from Slattery. For example, Applicant's claim 1 presently recites "...wherein a side of the frame comprises a variable configuration of panels, the configuration being selected by a user of the device...", referring to the frame being 'selectively configured'. Therefore, if this statement in the Action is intended to apply to Slattery, then the rejections of claims 1-7 and 14-16 under 35 U.S.C. § 102 cannot be sustained and should be reversed.

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B. CLAIMS 8-13 ARE NOT RENDERED OBVIOUS UNDER 35 U.S.C. § 103 OVER SLATTERY IN VIEW OF BACH

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed.Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

1. The basis of the rejection is ambiguous

On page 2 of the recent Action, claims 8-13 were rejected as being unpatentable over Slattery in view of Bach (US 6,439,225). Oddly, the remarks in the Action immediately follow with a reference to Hait, rather than Slattery, as a reference not formally introduced in the rejection but possibly referring to U.S. Patent 4,624,238 earlier made of record in the case. The remarks in the Action state here: "Hait is considered to disclose the claimed invention, as clearly anticipated under the rejection above, except for the claimed selective configuration."

Appellant is unsure whether the Examiner is indeed relying upon Hait or Slattery to be combined with Bach or whether all three references are being relied upon in combination with one another. As with the rejections under 35 U.S.C. § 102 addressed earlier, these remarks fall short of the requirements under 35 U.S.C. § 132 and unacceptably leave the Applicant to "shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner." (*In re*

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Oetiker, supra) Applicant respectfully submits that this defective or insufficient rejection should be reversed.

If the mention of Hait is a clerical error and the Examiner intends to refer to Slattery here, then Appellant notes that this is an admission that Slattery fails to meet limitations pertaining to selective configurability. Yet such limitations are recited in Applicant's independent claim 1. For example, Applicant's claim 1 presently recites "...wherein a side of the frame comprises a variable configuration of panels, the configuration being selected by a user of the device...", referring to the frame being 'selectively configured'. Therefore, if this statement in the Action is intended to apply to Slattery, then the rejections of claims 1-7 and 14-16 under 35 U.S.C. § 102 mentioned earlier, as well as the current rejections under 35 U.S.C. § 103, cannot be upheld and should be reversed.

2. Bach does not cure the acknowledged deficiencies of Hait

Appellant addresses the remainder of the remarks pertaining to how Bach allegedly discloses the 'selective configured' aspect at column 8, lines 5-49 to cure the deficiencies of Hait in this regard, as acknowledged by the Examiner. (Appellant notes also that if these deficiencies were intended to be acknowledged with respect to Slattery, then Bach still fails to cure the deficiency for at least the following reasons.) Appellant maintains, as argued in a previous response, that this passage of Bach describes the manner of folding the screened sides to permit their storage inside the unit when it is not in use and of unfolding the screens and setting them in place between the top and bottom sections of the unit in the context of a single, fixed while-in-use configuration. Moreover, the sides of the resulting enclosure formed by the screens of Bach do not provide for any variety of in-use configurations. In contrast, note that Applicant's

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independent claim 1, upon which claims 8-13 depend, recites that the frame "...comprises a variable configuration of panels, the configuration being selected by a user of the device to adjust an attribute of the enclosure when the device is in use for heating..." Bach does not teach or fairly suggest this variety of in-use configurations and does not fulfill this attribute reflected in Applicant's claims. Therefore, Bach does not cure the acknowledged lacking in Hait (or Slattery).

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The combination of these references applied in the rejection does not fulfill this requirement.

Furthermore, the Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). Appellant contends that Bach, Slattery, and Hait contain no such teaching, suggestion or motivation to be combined with one another in recognition of achieving the useful qualities of Applicant's claimed invention. Accordingly, the Office Action fails to establish *prima facie* obviousness based on a combination of these references. Especially with respect to dependent claims 8-11, the remarks in the Action fail to demonstrate how the references relied upon pertain in any way to employing a selectable quantity of panels, a selectable combination of panels or selective positioning of panels to form a given side of Applicant's frame.

Accordingly, claims 8-13 are allowable because the combination of references relied upon do not establish a *prima facie* case of obviousness. These references fail to teach or fairly suggest

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all of Applicant's limitations and, in addition, they lack any teaching, suggestion or motivation to be combined with one another. The rejection of claims 8-13 should be reversed.

Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Furthermore, the Office Action has simply engaged in impermissible hindsight. Recognizing, after the fact, that a modification or combination of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). No such factual basis has been provided.

In light of the foregoing arguments, Appellant respectfully requests that the rejections of claims 8-13 be reconsidered and reversed.

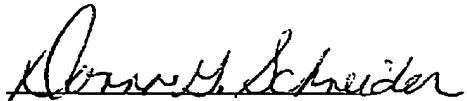
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VIII. CONCLUSION AND PRAYER FOR RELIEF

For the foregoing reasons, Appellant requests the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

12/15/05
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IX. CLAIMS APPENDIX

1. (Previously presented) A device facilitating the heating of items, the device comprising:
a collapsible frame for suspending an item above a heat source, the frame comprising:
a plurality of panels forming sides of the frame when the frame is erected, wherein a side of the frame comprises a variable configuration of panels, the configuration being selected by a user of the device to adjust an attribute of the enclosure when the device is in use for heating, the attribute including at least one of: how much of the side is enclosed, which portion of the side is enclosed, a volume substantially enclosed by the frame and an overall shape of the frame.
2. (Original) The device of claim 1 wherein a first panel is detachably coupled to a second panel and wherein the first and second panels are coupled to one another to erect the frame and detached from one another to collapse the frame.
3. (Original) The device of claim 2 wherein the first and second panels are detachably coupled substantially along their adjacent edges.
4. (Original) The device of claim 1 wherein the side of the frame is selectively configured by selectively employing a panel having particular physical dimension that affects the attribute of the enclosure.
5. (Original) The device of claim 1 wherein the side of the frame is selectively configured by selectively positioning a panel in a position relative to the remainder of the frame, the position affecting the attribute of the enclosure.

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6. (Original) The device of claim 1 wherein the side of the frame is selectively configured by selectively choosing among, in constructing the side, a first panel having a first measurement in a given dimension and a second panel having a second measurement in the dimension, the second measurement being different than the first.

7. (Original) The device of claim 6 wherein the dimension is measured in a substantially vertical direction relative to the vertical direction of the erected frame while in use.

8. (Original) The device of claim 1 wherein the side of the frame is selectively configured by employing a selectable quantity of panels, wherein the attribute is affected by the quantity of panels employed in forming the side.

9. (Original) The device of claim 1 wherein the side of the frame is selectively configured by selectively employing a combination of panels to form the side and selectively positioning the panels to affect both position and coverage how much of the side is enclosed and which portion of the side is enclosed.

10. (Previously presented) The device of claim 14 wherein the side of the frame is selectively configured by selectively employing a combination of panels to form the side and selectively positioning the panels to affect both how much of the side is enclosed and at what position the transverse member is supported by the frame.

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11. (Previously presented) The device of claim 14 wherein the side of the frame is selectively configured by selectively employing a combination of panels to form the side and selectively positioning the panels to affect both which portion of the side is enclosed and at what position the transverse member is supported by the frame.

12. (Previously presented) The device of claim 14 wherein the side of the frame that is selectively configurable comprises panels that support the transverse member.

13. (Original) The device of claim 12 wherein a panel comprises a first feature that engages with a mating second feature of the transverse member.

14. (Original) The device of claim 1 further comprising a transverse member for supporting the item to be heated, the transverse member being coupled to the frame.

15. (Original) The device of claim 14 wherein the transverse member is removably coupled to the frame and is removed from the frame when the frame is collapsed.

16. (Original) The device of claim 14 wherein the transverse member, when coupled to the frame, performs at least one of: maintaining shape of the frame, improving rigidity of the frame and holding in place the panels that form the frame.